

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

KAPALUA LAND CO., LTD.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92/040,092
)	
KAPALUA STRICKENWAREN)	Reg. Nos. 2,016,976 and 2,115,124
GmbH Ltd.,)	
)	
Registrant.)	

ANSWER TO FIRST AMENDED PETITION TO CANCEL

Registrant responds to Petitioner's First Amended Petition to Cancel as follows:

1. Kapalua is the owner and operator of KAPALUA, the internationally renowned resort in Maui, Hawaii, which Kapalua has operated since 1975. Kapalua has used the mark KAPALUA to identify its hotel and resort since at least 1975 and has used the mark KAPALUA on clothing products, soaps, shampoos and cosmetic products since at least as early as 1975. The trademark and service mark KAPALUA has become internationally well known and is a famous mark identifying Kapalua and products and services that originate from Kapalua.

ANSWER:

Registrant has insufficient information to form a belief as to the truth of the allegations of paragraph one of the First Amended Petition to Cancel and, therefore, denies same and leaves Petitioner to strict proof thereof.

2. The word KAPALUA is a word that has no meaning in any language, though it is identified on early maps of Maui as the name of a cove or beach on the property of the KAPALUA resort.

ANSWER:

Denied.



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3. On information and belief, Registrant is a corporation of the Federal Republic of Germany and has no relationship to Hawaii or Petitioner.

ANSWER:

Admitted.

4. Registration No. 2,016,976 is for the word trademark KAP ALUA for the goods "laundry bleach and laundry detergent, perfumes, essential oils for personal use, lipstick, rouge, eyeliner, hair lotion, and dentrifice" in International Class 003 and for "footwear, headwear, gloves" in International Class 025. Registration No. 2,115,124 is for the word trademark KAPALUA for "clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, gloves, and hats" in Class 025.

ANSWER:

Admitted.

COUNT 1 - ABANDONMENT

5. On information and belief, KSG does not use the mark KAPALUA in the United States on the goods identified in Registration No. 2,016,976, has not done so for more than three years and has no intention to use the mark on those goods in the future. On information and belief, KSG does not use the mark KAPALUA in the United States on the goods identified in registration No. 2,115,124 and has not used the mark on such goods for more than three years and has no intention to use the mark on those goods in the future.

ANSWER:

Registrant has allowed Registration No. 2,016,976 to be cancelled and, therefore, the allegation regarding this registration is moot and no response is required. Registrant denies the allegations regarding Registration No. 2,115,124.

6. The continued maintenance of Registration Nos. 2,016,976 and 2,115,124 for the mark KAPALUA by KSG for the goods identified in those registrations will preclude the registration and will threaten the use of the mark KAPALUA by Kapalua.

ANSWER:

Denied.

COUNT II - LIKELIHOOD OF CONFUSION

7. The marks of Kapalua and KSG are identical. As a result of Kapalua's continued use of the trademark and service mark KAPALUA it has become internationally well known and is a famous mark identifying Kapalua and products and services that originate with Kapalua.

ANSWER:

Denied.

8. On information and belief, if KSG uses its mark in the United States, the consumer for the goods of KSG will be the same or similar consumer of Kapalua's goods and services.

ANSWER:

Registrant has insufficient information to form a belief as to the truth of the allegations of paragraph eight of the First Amended Petition to Cancel and, therefore, denies same and leaves Petitioner to strict proof thereof.

9. The continued maintenance of the Registrations Nos. 2,016,976 and 2,115,124 on the Principal Register is likely to cause confusion, and is likely to deceive and mislead consumers and should, therefore, be cancelled under Section 14 of the Lanham Act.

ANSWER:

Denied.

COUNT III - DILUTION

10. The service mark and trademark KAPALUA is a famous mark identifying Kapalua's internationally famous resort and hotel on the island of Maui, Hawaii. Kapalua's use of the KAPALUA trademark and service mark since 1975, and its extensive advertising and promotion of the mark throughout the United States and the world has caused the mark KAPALUA to become famous and to identify only Petitioner.

ANSWER:

Denied.

11. The maintenance of the Registrations Nos. 2,016,976 and 2,115,124 on the

Principal Register dilutes the fame of the mark KAPALUA of Petitioner for its like goods and services marketed to the same or similar consumers and said dilution will cause harm to the reputation and fame of the KAPALUA mark of Petitioner.

ANSWER:

Denied.

COUNT IV - FRAUD on the Patent and Trademark Office, Reg. No. 2,115,124

12. Respondent has committed fraud on the Patent and Trademark Office in its filing of its Section 8 Affidavit.

ANSWER:

Denied.

13. On May 19, 2004, Respondent filed its Declaration of Continued Use for Registration No. 2,115,124. Attached as Exhibit A is that filing. In that filing, Respondent declared that it was using the mark on all of the goods listed in the registration as of May 19, 2004.

ANSWER:

Admitted.

14. On October 28, 2005, Petitioner served its First Set of Interrogatories on Respondent. See attached as Exhibit B. Respondent answered those Interrogatories on December 16, 2005. Attached as Exhibit C are those responses.

ANSWER:

Admitted.

15. In its Responses to Petitioner's First Set of Interrogatories, Respondent provided the following answer to Interrogatory No.3:

Interrogatory No. 3

Identify each product on which Respondent has used Respondent's Mark.

Answer:

Pullovers, t-shirts and skirts.

ANSWER:

Admitted.

16. Respondent's verified response to Interrogatory No. 3 contradicts the information provided in Respondent's Section 8 filing.

ANSWER:

Admitted.

17. Respondent filed its Section 8 declaration and fraudulently declared it was using its mark on all the goods listed in Registration No. 2,115,124, namely, clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, gloves, and hats. In its verified answers to Interrogatories served and answered in this case, Respondent indicated that it had only used the mark on pullovers, t-shirts and skirts.

ANSWER:

Registrant denies that it fraudulently declared it was using its mark on all the goods listed in Registration No. 2,115,124. Registrant admits that in its verified answers to Interrogatories served and answered in this case, Respondent indicated that it had only used the mark on pullovers, t-shirts and skirts.

18. By filing the incorrect Section 8 declaration, Respondent has committed fraud on the Patent and Trademark Office.

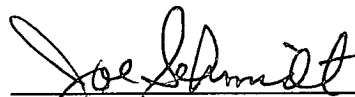
ANSWER:

Denied.

WHEREFORE, Registrant requests that the First Amended Petition to Cancel be dismissed as to all counts.

Dated: May 22, 2006

By: _____



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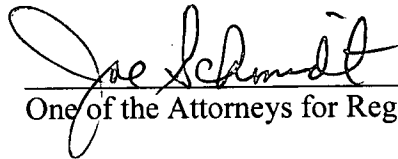
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Attorneys for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **REGISTRANT'S ANSWER TO FIRST AMENDED PETITION TO CANCEL** was served by first class mail, postage pre-paid, on this 22nd day of May upon:

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A handwritten signature in cursive script, appearing to read "Joe Schmidt", is written over a horizontal line.

One of the Attorneys for Registrant